

REMARKS

The objection to claims 2 and 3 and the indication that such claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is acknowledged. Applicants note that by the present amendment, claim 1 has been canceled and dependent claim 2 has been written in independent form incorporating all of the limitations of parent claim 1 therein, such that claim 2 should now be in condition for allowance. Since claim 3 depends from claim 2, such claim has been retained in dependent form and should be considered allowable with parent claim 2.

Also, by the present amendment, informalities in the specification have been corrected, and claims 4-6 have been amended, where appropriate, to depend directly or indirectly from claim 2, such that applicants submit that claims 4-6 should also be in condition for allowance at this time. Claims 7-11 have been canceled without prejudice or disclaimer of the subject matter thereof, noting that although claims 9 and 10 have been objected to as being in improper form, applicants submit that a Preliminary Amendment of February 7, 2002 in this application, placed such claims in proper multiple dependent form and the objection to claims 9 and 10 is considered to be improper. However, as noted, such claims have been canceled and applicants submit that new claims 12-17 which correspond to features of claims 7-11 should now be in condition for allowance, as will become clear from the following discussion.

Also, submitted herewith are proposed drawing corrections and corrected drawings, in which Figs. 11a, 11b and 12 have been designated as "Prior Art" as required by the Examiner. Accordingly, acceptance of all drawings in this application is respectfully requested.

As to the rejection of claims 1, 4, 5, 7, 8 and 11 under 35 U.S.C. 102(b) as being clearly anticipated by Jones; the rejection of claims 7, 8 and 11 under 35

U.S.C. 102(b) as being anticipated by Hagen et al; and the rejection of claim 6 under 35 U.S.C. 103(a) as being unpatentable over Jones; such rejections are traversed insofar as they are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further

noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

As noted above, claim 1 has been canceled and claim 2 written in independent form, such that applicants submit that claim 2 and its dependent claims 3-6 should be now be in condition for allowance. Thus, applicants submit that the rejections over the cited art of claims 1, 4, 5 and 6 should now be overcome and a discussion of the cited art in relation thereto is considered unnecessary.

With respect to the newly added claims, new independent claim 12 corresponds to the features previously set forth in claim 7, while further defining the features of side-coil connecting portions provided on both sides of said base coil portion, wherein said pair of side coil portions are attached by said side-coil

connecting portions to said base coil portion so as to be movable at an arbitrary angle with respect to said base coil portion, and said center coil portion enables coupling of said pair of said side coil portions together. Referring to Figs. 1 and 2 of the drawings of this application and as described in the paragraph bridging pages 9 and 10 of the Substitute Specification, the side-coil connecting portions 25 are formed on both sides of the base coil portion 11, and the side coil portions 12 are to be attached in such a way as to be movable at an arbitrary angle with respect to the base coil portion 11. Thus, the side coil portions 12 are openable, as shown in Fig. 2, to facilitate attachment of the body probe to the subject at the time of attachment and the side coil portions 12 can be attached from the base coil portion 11 at the positions of the side-coil connecting portions 25. Furthermore, as shown in Figs. 1A and 1B, the center coil portion 13 enables connection of the two side coil portions 12 at the center of the chest of the subject. As such, a more versatile body probe is obtained.

Turning to Jones, irrespective of the position by the Examiner, and as apparently recognized by the Examiner, assuming arguendo that Jones provides a center coil portion 16 and two side coil portions 12, 14 as contended by the Examiner, it is not seen that Jones also provides a base coil portion and side-coil connecting portions provided on both sides of the base coil portion. Likewise, it is apparent that there is no disclosure or teaching in Jones that the pair of side coil portions are attached by the side-coil connecting portions to the base coil portion so as to be movable at an arbitrary angle with respect to the base coil portion, and that the center coil portion enables coupling of the pair of side coil portions together. Accordingly, applicants submit that the features as recited in new independent claim 12 and therewith the dependent claims patentably distinguish over Jones in the sense of 35 U.S.C. 102 and 35 U.S.C. 103.

With respect to new independent claim 17, applicants note that such claim is an independent claim directed to an MRI apparatus using a body probe having the features as recited in claim 12 set forth in claim 17, and applicants submit that Jones also fails to disclose or teach this claimed subject matter in the sense of 35 U.S.C. 102 or 35 U.S.C. 103. Thus, applicants submit all claims present in this application patentably distinguish over the cited art and should be considered allowable thereover.

With respect to Hagen et al, while the Examiner refers to Figs. 12 and 13, contending that there is provided a base coil portion 6B attached to the base 24, side coil portions 4A, B and center coil portion 6A which lies between the side coil portions, applicants submit that the Examiner's position is a mischaracterization of Hagen et al. In any event, assuming arguendo that the Examiner's position may be proper, it is readily apparent that Hagen et al does not disclose or teach side-coil connecting portions provided on both sides of the base coil portion, wherein the side coil portions are attached by the sub-coil connecting portions to the base coil portion so as to be movable at an arbitrary angle with respect to the base coil portion, and the center coil portion enables coupling of the pair of side coil portions together. Applicants submit that there is no disclosure or teaching of this structural arrangement as recited in independent claim 12 as well as independent claim 17 by Hagen et al in the sense of 35 U.S.C. 102 or 35 U.S.C. 103. Thus, applicants submit that the independent claims 12 and 17 and the dependent claims patentably distinguish over Hagen et al and should be considered allowable thereover.

With respect to the dependent claims 13-16, applicants note that such claims recite further features which when considered in conjunction with the features of parent claim, further patentably distinguish over the cited art. It is noted that claim 13 recites the feature that the base coil portion is provide with a head holder for holding the head of a subject to be examined, claim 14 recites the feature that the

center coil portion, the pair of side coil portions and the base coil portion are constructed independently of one another, claim 15 recites the feature that the side coil portions are constructed by embedding a flexible coil in a soft member and claim 16 recites the feature that the side coil portions are provided with cutaway holes at portions where there are no coil portions. Applicants submit that neither Jones nor Hagen et al disclose or teach such claimed features when considered in conjunction with parent claim 12, and applicants submit that all claims patentably distinguish over this cited art in the sense of 35 U.S.C. 102 and/or 35 U.S.C. 103.

In view of the above amendments and remarks, applicants submit that all claims present in this application are in proper form and patentably distinguish over the cited art. Accordingly, issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (520.40710X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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